

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Noonan**

Serial No. **10/624,322**

Filed: **July 22, 2003**

For: **System and Method of Updating
Planogram Information Using RFID
Tags and Personal Shopping Device**

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Group Art Unit: **2166**

Examiner: **Ahn, Sangwoo**

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

39698
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on September 28, 2006.

A fee of \$500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 50-0563. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 50-0563. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 50-0563.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

I. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-20

II. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-20
4. Claims allowed: None
5. Claims rejected: 1-20
6. Claims objected to: None

III. CLAIMS ON APPEAL

The claims on appeal are: 1-20

STATUS OF AMENDMENTS

No amendments were filed after the final office action dated August 22, 2006.

SUMMARY OF CLAIMED SUBJECT MATTER

I. CLAIM 1 - INDEPENDENT

The subject matter of claim 1 is directed to a method for updating a retail planogram (Specification, summary of the invention, p. 3, para. 3, l. 1; Specification, detailed description, p. 4, para. 2, l. 1). The method includes reading an electronic transmission (Specification, detailed description, p. 5, para. 4, ll. 5-7) from at least one RFID tag in a retail environment located in proximity to a product (Specification, detailed description, p. 5, para. 4, ll. 1-3). The reading step is performed using a personal shopper device (Specification, detailed description, p. 5, para. 4, ll. 5-7) having a location sensing mechanism (Specification, detailed description, p. 4, para. 2, l. 2; Specification, detailed description, p. 4, para. 4, ll. 2-8), a memory (Specification, detailed description, p. 5, para. 2, l. 8), a software means (Specification, detailed description, p. 6, para. 1, ll. 1-7; Figure 1, ref. num. 140-150), and an RFID reader (Specification, detailed description, p. 4, para. 2, l. 2), wherein an initial planogram is stored therein (Specification, detailed description, p. 6, para. 1, ll. 1-11). The method further includes collecting said read electronic location information transmitted from said at least one RFID tag by said shopper device (Specification, detailed description, p. 6, para. 1, ll. 1-11), analyzing and comparing said collected location information by said software means of said shopper device (Specification, detailed description, p. 6, para. 1, ll. 1-11), with said initial planogram in relation to initial location information of said product with collected location information for said product from said collected information (Specification, detailed description, p. 6, para. 1, ll. 1-11), updating said initial location information for said product in said initial planogram in response to collected location information to provide an updated planogram to display current location information for said product in a current planogram arrangement in said retail environment (Specification, detailed description, p. 6, para. 1, ll. 1-11).

II. CLAIM 10 - INDEPENDENT

The subject matter of claim 10 is directed to a system for updating a planogram (Specification, summary of the invention, p. 3, para. 3, l. 1; Specification, detailed description, p. 4, para. 2, l. 1). The system includes personal shopper device (Specification, detailed

description, p. 4, para. 2, ll. 1-2) having a location sensing means (Specification, detailed description, p. 4, para. 2, l. 2; Specification, detailed description, p. 4, para. 4, ll. 2-8), a software means (Specification, detailed description, p. 6, para. 1, ll. 1-7; Figure 1, ref. num. 140-150) and an RFID reader (Specification, detailed description, p. 4, para. 2, l. 2). The system further includes a retail system (Specification, detailed description, p. 4, para. 3, l. 1), which includes a database (Specification, detailed description, p. 4, para. 3, l. 1) in communication with said shopper device (Specification, detailed description, p. 4, para. 3, ll. 2-9), an initial planogram stored in said database (Specification, detailed description, p. 6, para. 2, ll. 1-9), and one or more product RFID shelf labels positioned in a retail environment (Specification, detailed description, p. 5, para. 4, ll. 1-3), wherein said RFID reader is capable of reading an electronic transmission from at least said one or more RFID shelf labels (Specification, detailed description, p. 5, para. 4, ll. 5-7) using said personal shopper device and transmitting collected read electronic information to said database, wherein said initial planogram is updated in response to collected read electronic information by said software means and said database is updated with a current planogram reflecting said collected read electronic information (Specification, detailed description, p. 6, para. 2, ll. 1-9).

III. CLAIM 19 - INDEPENDENT

The subject matter of claim 15 is directed to a system for generating an updated planogram in a retail environment (Specification, summary of the invention, p. 3, para. 3, l. 1; Specification, detailed description, p. 4, para. 2, l. 1). The system includes a portable shopper device (Specification, detailed description, p. 4, para. 2, ll. 1-2) having a location sensor (Specification, detailed description, p. 4, para. 2, l. 2; Specification, detailed description, p. 4, para. 4, ll. 2-8), comparative software (Specification, detailed description, p. 6, para. 1, ll. 1-7; Figure 1, ref. num. 140-150) and an RFID reader (Specification, detailed description, p. 4, para. 2, l. 2). The system further includes a retail system (Specification, detailed description, p. 4, para. 3, l. 1), which includes a server (Specification, detailed description, p. 4, para. 3, l. 1), a database (Specification, detailed description, p. 4, para. 3, l. 1) in communication with said shopper device (Specification, detailed description, p. 4, para. 3, ll. 2-9), a wireless communication network (Specification, description of related art, p. 2, para. 1, ll. 2-3), an initial

planogram stored in said database(Specification, detailed description, p. 6, para. 2, ll. 1-9), and a plurality of product RFID shelf labels positioned in proximity to each of their respective products (Specification, detailed description, p. 5, para. 4, ll. 1-3), wherein said RFID reader reads product location information electronically transmitted from at least one of said plurality of product RFID shelf labels using said personal shopper device (Specification, detailed description, p. 6, para. 1, ll. 1-11) and said comparative software compares initial product location information of said initial planogram with said read product location information (Specification, detailed description, p. 6, para. 1, ll. 1-11) and updates said initial planogram in response to said read product location information (Specification, detailed description, p. 6, para. 1, ll. 1-11)and said database is updated with a current planogram in relation to said read product location information(Specification, detailed description, p. 6, para. 2, ll. 1-9).

IV. CLAIM 2 - DEPENDENT

The method of claim 1, wherein said device is fixedly mounted to a shopping cart (Specification, description of related art, p. 2, para. 1, l. 5).

V. CLAIM 11 - DEPENDENT

The system of claim 10, wherein said software means is software that compares initial product location information with collected product location information and identifies differences therebetween (Specification, detailed description, p. 6, para. 1, ll. 1-7; Figure 1, ref. num. 140-150).

VI. CLAIM 12 – DEPENDENT

The system of claim 11, wherein said location sensing means reads coordinates from known location points within said retail environment to determine a coordinate location point of said shopper device at an instant of time (Specification, detailed description, p. 4, para. 2, l. 2; Specification, detailed description, p. 4, para. 4, ll. 2-8).

VII. CLAIM 17 – DEPENDENT

The system of claim 11, further comprising a display for displaying an updated planogram (Specification, detailed description, p. 4, para. 3, l. 4).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. GROUND OF REJECTION 1 (Claims 1, 3-5, 7-12, 14-16, and 18-20)

Whether claims 1, 3-5, 7-12, 14-16, and 18-20 are anticipated by *Neumark*, System for Cataloging an Inventory and Method of Use, United States Patent No. 6,550,674 B1 (issued April 22, 2003), under 35 U.S.C. § 102(e);

II. GROUND OF REJECTION 2 (Claims 2, 6, and 13)

Whether claims 2, 6, and 13 are obvious over *Neumark*, System for Cataloging an Inventory and Method of Use, United States Patent No. 6,550,674 B1 (issued April 22, 2003), in view of *Hind et al.*, Method and system for providing targeted advertising and personalized customer services, United States Patent Application Publication No. US 2002/0174025 A1 (published November 21, 2002), under 35 U.S.C. § 103(a); and

III. GROUND OF REJECTION 3 (Claim 17)

Whether claim 17 is obvious over *Neumark*, System for Cataloging an Inventory and Method of Use, United States Patent No. 6,550,674 B1 (issued April 22, 2003), in view of *Hoffman et al.*, Customer Guidance System for Retail Store, United States Patent Application Publication No. US 2002/0178013 A1 (published November 28, 2002), under 35 U.S.C. § 103(a).

ARGUMENT

I. GROUND OF REJECTION 1

The Examiner has rejected claims 1, 3-5, 7-12, 14-16 and 18-20 under 35 U.S.C. § 102(e) as being anticipated by *Neumark*, System for Cataloging an Inventory and Method of Use, United States Patent 6,550,674 (April 22, 2003) (hereinafter, “*Neumark*”). This rejection is respectfully traversed.

I.A. Group A: Claims 1, 3-5, and 7-9

The Examiner has rejected claim 1 stating:

As per claim 1, *Neumark* discloses,

A method for updating a retail planogram comprising the steps of reading an electronic transmission from at least one RFID tag in a retail environment located in proximity to a product, using a personal shopper device having a location sensing mechanism (column 4 lines 65 - 66, et seq.), a memory (column 4 lines 52 - 54, et seq.), a software means (data file creating capability means there is a software), and an RFID reader (column 4 line 51, column 5 lines 57 - 58, et seq.), wherein an initial planogram is stored therein (Figure 1, column 5 lines 36 - 64, column 6 lines 6 - 42, et seq.),

collecting said read electronic location information transmitted from said at least one RFID tag by said shopper device (column 4 lines 52 - 56, column 5 line 57, et seq.),

analyzing and comparing said collected location information by said software means of said shopper device, with said initial planogram in relation to initial location information of said product with collected location information for said product from said collected information (column 7 line 48 - column 8 line 5, et seq.),

updating said initial location information for said product in said initial planogram in response to collected location information to provide an updated planogram to display current location information for said product in a current planogram arrangement in said retail environment (column 7 line 48 - column 8 line 5, et seq.).

Final office action dated August 22, 2006, pp. 5-6.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining

patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Claim 1 is representative of claims 1, 3-5, and 7-9 in this group and recites:

A method for updating a retail planogram comprising the steps of
reading an electronic transmission from at least one RFID tag in a retail environment located in proximity to a product, using a personal shopper device having a location sensing mechanism, a memory, a software means, and an RFID reader, wherein an initial planogram is stored therein,

collecting said read electronic location information transmitted from said at least one RFID tag by said shopper device,

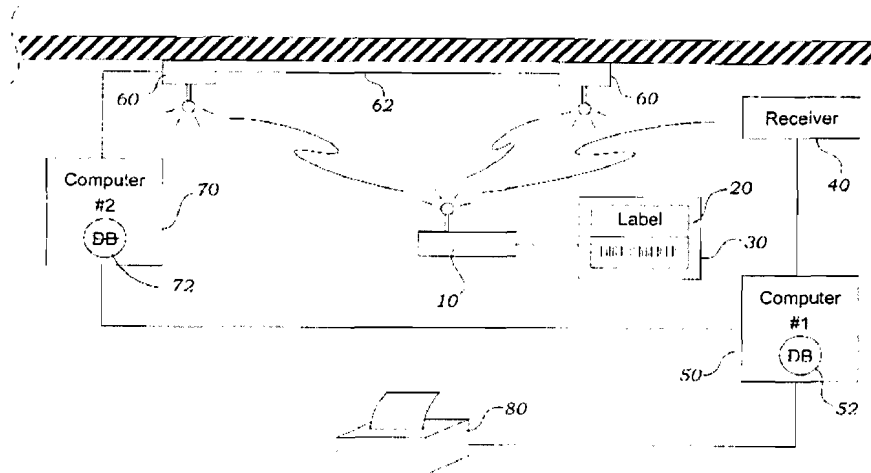
analyzing and comparing said collected location information by said software means of said shopper device, with said initial planogram in relation to initial location information of said product with collected location information for said product from said collected information,

updating said initial location information for said product in said initial planogram in response to collected location information to provide an updated planogram to display current location information for said product in a current planogram arrangement in said retail environment.

Neumark does not teach or disclose all of the features in claim 1. For example, the reading step of claim 1 is not taught by this cited reference. Particularly with respect to the reading step, *Neumark* does not teach, “wherein an initial planogram is stored therein.”

Neumark also does not teach the analyzing step and the updating step of claim 1.

The Examiner points to Figure 1 in this cited reference as teaching this feature in the reading step:



Neumark, Figure 1.

At issue are the contents of the reader identified by reference numeral 10 in *Neumark's* figure 1. *Neumark* describes this reader as “mobile means for reading labels and for communication (R&C). *Neumark* provides the following elaboration of the reader’s functions, contents, and capabilities as follows:

The present invention is a method wherein a combination mobile means for reading labels and for communication (R&C) 10 is employed. One such device or hundreds may be used at the same time depending on the size and nature of the inventory management objective. In this description, we refer to a single R&C 10, but it should be realized that many such units would normally be employed simultaneously in the present method. The communication means of the R&C 10 provides two wireless functions. To accomplish its objectives the communication means is able to transmit digital information over relatively short distances, as allowed by FCC rules, employing any well known and common analog or digital wireless communication technique as described in the prior art. It also is able to transmit a low power ultra wide band (UWB) communication signal which is particularly suitable in the present application, as will be shown. Other communication protocols that are well known in communication engineering could be used in place of UWB. Likewise, the label reading means part of the R&C 10 may be any well known optical, mechanical, electrical, electrostatic, or magnetic system for reading bar code or other printed coding. Such inventory labels may be radio tags, bar code labels and other well known tags capable of labeling inventory. However, the reader must be of the type that requires its position to be quite close or in contact with the label to be read. Such proximity readers include magnetic swipe types, optical bar code types, and others. Proximity is necessary because the communication means part of the R&C 10 enables the location of the reader, i.e., the item being read,

to be determined. When the reader is close to the item, or touching it, and when the communication means is, likewise, very close, the accuracy of the location is improved. Therefore, it is a preferred technique to use a single, miniature hand-held device with contact label reading and communication capabilities. The importance of the proximity of the R&C 10 to the inventory item will be understood in the following disclosure.

The method includes the step of manually positioning the R&C 10 for taking a reading, and then taking a reading of an inventory label 20 or other indicia affixed to, or adjacent to, a selected inventory item 30 in an inventory stores. This process may be repeated for one item after the next until an entire inventory of stores is taken, or it may be completed for only one or a few items as desired. A common need in inventory management is to determine the nature or identity of inventory items and also their location, and the present method can accomplish this economically and efficiently. The next step in the present invention method is to create a data file in the R&C corresponding to the label reading and a corresponding first time stamp taken at the time of the label reading. Thus, the R&C 10 has a data file creating capability as is known in the art, and also has a time stamping capability, as is also well known in the art.

Neumark, col. 5, l. 36 – col. 6, l. 21.

Neumark describes the reader, the R&C device 10, covering the various aspects of the device's label reading and communications capabilities. The description provides details of types of labels to be read, positioning of the R&C device with respect to the inventory items and labels affixed to those items, and nature of the communication capabilities. Notably absent from the description is the existence of any planogram related computations in the R&C device. In the entire detailed description of the R&C device's capabilities, the data storing capabilities are limited to creating data file and time stamping. No description is provided about storing a planogram in the R&C device.

In addition to *Neumark*'s section cited above, the examiner also cites to the following portion of *Neumark* as teaching this claimed feature:

This step is known, for instance, in the supermarket and grocery trade, each time an item is scanned at a checkout counter, its identity is recorded as a data file, which is then imported into a database and the current known inventory count of the item is reduced by one. Similarly here, the data file is transmitted by wireless communication, as described above and shown in FIG. 1, from the R&C to a receiver 40 using any well known method of moving data from a point of origin to a point where analysis will be conducted, and preferably employs digital wireless transmission. In like manner, the data file is transported, usually over an

electrical cable, from the receiver 40 to a first data processor 50 such as any digital computer where the data file is stored in a database as a record. Such a record will contain information such as, item description, item serial or stocking number, item count or quantity, item date, and so on. The record also contains the date and time of day that the reading took place. The data base may contain hundreds, or many hundreds of such records, and the means for creating such a database and of importing information, such as describe here, into the database is very well known in the art.

Neumark, col. 6, ll. 21-42.

As can be seen, this cited section from *Neumark*, explains the R&C device's label reading, data capturing, and communication capabilities. *Neumark* expressly provides for databases in first data processor 50, and second data processor 70, which provide the inventory management function by utilizing data communicated by the label reader R&C device. However, the cited sections from *Neumark* are devoid of any disclosure of a planogram stored in *Neumark*'s label reader. In fact, *Neumark*'s entire disclosure fails to teach or suggest a feature similar to "wherein an initial planogram is stored therein" as recited in claim 1. The claimed feature recites the existence of a planogram in the shopper device. Planogram is defined in the specification, as follows:

a planogram is how a retailer's configure a layout of their respective stores

Specification, p. 2.

Neumark does not disclose storing a planogram in the label reader R&C device. According to *Neumark*'s disclosure, the label reader sends the data to a data processor Computer #1 shown as reference numeral 50 in *Neumark*'s figure 1. *Neumark*'s figure 1 shows, and the detailed description explains that the data processor is distinct from the label reader, and the data processor provides the database 52 of inventory items. *Neumark*'s second data processor Computer #2, shown as reference numeral 70 in *Neumark*'s figure 1 provides the computational capabilities for determining the location of the label reader and populates a second database 72 with running account of the label reader's location. The location of an inventory item in *Neumark*'s system is then determined by matching item label information from the first database 52, to location information from the second database 72, based on the time of the reading of the label.

Neumark does not disclose a planogram stored in the label reader device. Therefore, *Neumark* does not disclose any use of an initial planogram resident on the label reader. Not only does *Neumark* not disclose a planogram residing in the label reader, *Neumark* does not even disclose a planogram stored in the two databases. Furthermore, any computations involving locations that may vaguely resemble similar computations involving planograms are carried out in the two data processors, external to the label reader. Therefore, *Neumark* does not teach “wherein an initial planogram is stored therein” as recited in claim 1.

Neumark is not concerned with planograms as defined and used in the invention of claim 1, but only with learning the location of items in the warehouse space at specific times for inventory management. By definition, location of inventory items and a planogram are distinct from each other, and *Neumark* teaches the former, not the latter. The invention of claim 1 as a whole pertains to “a method for updating a retail planogram,” and *Neumark* does not teach or suggest updating a retail planogram as in the claimed invention. Therefore, *Neumark* does not teach the feature “wherein an initial planogram is stored therein” as claimed, and cannot suggest storing a planogram in *Neumark*’s label reader.

Neumark fails to disclose another feature of the claim 1, namely, “analyzing and comparing said collected location information by said software means of said shopper device, with said initial planogram in relation to initial location information of said product with collected location information for said product from said collected information.” Because *Neumark*’s invention contains no disclosure of a planogram in the label reader device, *Neumark* cannot teach comparing anything to a planogram in the label reader device. *Neumark* uses the reader only to collect the label information, and uses the label information in conjunction with two separate databases that are external to the reader to identify the location of an item in place and time. The analysis and comparison of the label information does not occur using any software component resident on the reader device, as contrasted with the analysis and comparison activity in the invention of claim 1. Therefore, *Neumark* cannot teach comparing a product location on the initial planogram with the product location as collected by the personal shopper device from reading a product’s RFID tag in claim 1.

For the same reason, yet another feature of claim 1 is not anticipated by *Neumark*, namely, “updating said initial location information for said product in said initial planogram in

response to collected location information to provide an updated planogram to display current location information for said product in a current planogram arrangement in said retail environment.” Because *Neumark*’s invention does not contain a planogram, no update of a planogram is possible, and *Neumark* cannot yield a current planogram arrangement as claimed. Therefore, *Neumark* cannot teach updating a product’s location in a planogram as claimed in claim 1. At least for the three features of claim 1 that *Neumark* fails to disclose as described above, *Neumark* does not anticipate claims 1, 3-5, and 7-9 under 35 U.S.C. § 102(e).

The Examiner responds to these distinctions by stating:

1. Applicant defined a planogram as how retailers configure a layout of their respective stores. *Neumark* teaches that it is possible to determine where any item is located (layout = location of the items) within the stores (column 5 line 2, et seq.), by using the disclosed inventory control and management method. In addition, *Neumark* discloses that a running account of the locations of the R&C over time and the location information are recorded with date and time. This means that the location information is being updated continuously, to determine the exact location of various products within the store. These records are stored and kept in the databases for the next update as well. Since the R&C device is capable of reading and determining the location, creating a data file comprising the information collected, it is inherent that the device could store various product information including its location.

Final office action dated August 22, 2006, pp. 3-4.

The examiner’s arguments are deficient in at least two respects. First, the examiner has still not shown where *Neumark* teaches a planogram stored in *Neumark*’s R&C device that would correspond to the feature, “wherein an initial planogram is stored therein” as recited in claim 1. For anticipation, a reference must show each and every feature of the claim identically as arranged in the claim. *In Re Lowry*.

Second, the examiner has only made a general assertion that “it is inherent that the device could store various product information including its location” about *Neumark*’s R&C device, without pointing to anything in the reference that would support the examiner’s assertion. Again, for anticipation, a reference must show each and every feature of the claim identically as arranged in the claim. *In Re Lowry*. Furthermore, even if, *arguendo*, *Neumark* were to support the examiner’s assertion, the showing would still be insufficient to show that the alleged location

stored in the R&C device teaches, “wherein an initial planogram is stored therein” identically as recited in claim 1. This insufficiency would exist because the definition of the planogram is distinct from location of items. Therefore, the examiner’s response does not overcome the reasons presented against *Neumark’s* anticipation of claim 1. Accordingly, Applicants request that the Board of Patent Appeals and Interferences reverse the rejection and direct the examiner to allow the claims in group A.

I.B. Group B: Claims 10-12, 14-16, 18-20

The Examiner has rejected claims 10-12, 14-16, and 18-20, stating:

As per claim 10, Neumark discloses,
A system for updating a planogram comprising,
a personal shopper device having a location sensing means, a software means and an RFID reader (Figure 1, column 4 line 47 - column 5 line 3, et seq.)
a retail system comprising a database in communication with said shopper device (Figure 1, column 4 lines 50 - 60, et seq.),
an initial planogram stored in said database (column 8 lines 1 - 3, et seq.), and
one or more product RFID shelf labels positioned in a retail environment (column 4 lines 50 - 52, column 6 lines 6 - 9, et seq.),
wherein said RFID reader is capable of reading an electronic transmission from at least said one or more RFID shelf labels using said personal shopper device and transmitting collected read electronic information to said database, wherein said initial planogram is updated in response to collected read electronic information by said software means and said database is updated with a current planogram reflecting said collected read electronic information (column 4 line 65 - column 5 line 3, column 7 line 48 - column 8 line 5, et seq.).

Final office action August 22, 2006, pp. 7-8.

Claim 10 is representative of claims 10-12, 14-16, and 18-20 in this group, and recites:

10. A system for updating a planogram comprising,
a personal shopper device having a location sensing means,
a software means and an RFID reader,
a retail system comprising a database in communication with said shopper device,
an initial planogram stored in said database, and
one or more product RFID shelf labels positioned in a retail environment,
wherein said RFID reader is capable of reading an electronic transmission from at least said one or more RFID shelf labels

using said personal shopper device and transmitting collected read electronic information to said database, wherein said initial planogram is updated in response to collected read electronic information by said software means and said database is updated with a current planogram reflecting said collected read electronic information.

Contrary to the Examiner's assertion, *Neumark* does not teach, "an initial planogram stored in said database." In the sections that the Examiner cites from *Neumark* as teaching this claim feature, *Neumark* states:

To determine the location and identity of an item 30 within inventory stores, it now is possible to call-up the record of the item 30, in the first database 52 to determine item identity and time of record, and then by matching the time of location in the second database 72 to the time of record, to obtain location.

Neumark, col. 7, l. 55 - col. 8, l. 4.

The cited sections from *Neumark* are devoid of any disclosure of a planogram stored in *Neumark's* two databases. In fact, *Neumark's* entire disclosure fails to teach or suggest a feature similar to "an initial planogram stored in said database" as claimed. The claimed feature recites the existence of a planogram in the database. A planogram is how retailers configure a layout of their respective stores. *Neumark* is not concerned with planograms as defined and used in the claimed invention, but only with learning the location of items in the warehouse space at specific times for inventory management. By definition, location of inventory items and a planogram are distinct from each other, and *Neumark* teaches the former, not the latter. Claim 10 recites specific steps for updating a planogram and *Neumark* does not teach or suggest updating a planogram as claimed. Therefore, *Neumark* does not teach the feature "an initial planogram stored in said database" as claimed in claim 10, and cannot suggest storing a planogram in either of the two databases in *Neumark's* system.

For the same reasons, *Neumark* also does not anticipate the claimed feature "wherein said initial planogram is updated in response to collected read electronic information by said software means." Where no planogram exists, no planogram can be updated, and no updating of planograms can be taught. At least for the two features of claim 10 that *Neumark* fails to disclose as described above, *Neumark* does not anticipate claims 10-12, 14-16, and 18-20 under 35 U.S.C. § 102(e).

The Examiner responds to these distinctions by stating:

1. Applicant defined a planogram as how retailers configure a layout of their respective stores. *Neumark* teaches that it is possible to determine where any item is located (layout = location of the items) within the stores (column 5 line 2, et seq.), by using the disclosed inventory control and management method. In addition, *Neumark* discloses that a running account of the locations of the R&C over time and the location information are recorded with date and time. This means that the location information is being updated continuously, to determine the exact location of various products within the store. These records are stored and kept in the databases for the next update as well. Since the R&C device is capable of reading and determining the location, creating a data file comprising the information collected, it is inherent that the device could store various product information including its location.

Final office action dated August 22, 2006, pp. 3-4.

The Examiner asserts that updating location information in the databases is the same as updating a planogram. As reasoned above, planogram is how retailers configure a layout of their respective stores. *Neumark* is not concerned with planograms as defined and used in the claimed invention, but only with learning the location of items in the warehouse space at specific times for inventory management. By definition, location of inventory items and a planogram are distinct from each other, and *Neumark* teaches the former, not the latter. Claim 10 recites specific steps for updating a planogram and *Neumark* does not teach or suggest updating a planogram as claimed. The examiner has again failed to show in the reference, each and every feature of the claim identically as arranged in the claim. *In Re Lowry*.

The reference does not support the examiner's conclusion that location and planogram are one and the same. Because the reference does not teach a planogram, the reference cannot teach updating a planogram. Therefore, the examiner's response does not overcome the reasons presented against *Neumark's* anticipation of claim 10. Accordingly, Applicants request that the Board of Patent Appeals and Interferences reverse the rejection and direct the examiner to allow the claims in group B.

II. GROUND OF REJECTION 2 (Claims 2, 6, and 13)

Group C: Claims 2, 6, and 13

The Examiner has rejected claims 2, 6, and 13 under 35 U.S.C. § 103(a) as being obvious over *Neumark* in view of *Hind* et al., Method and system for providing targeted advertising and personalized customer services, United States Patent Application 2002/0174025 (Filed, May 17, 2001, Published, November 21, 2003) (hereinafter, "*Hind*"). This rejection is respectfully traversed. The Examiner notes on page 7 of the office action that the obviousness rejection applies to claims 2, 16, and 13, but continues to describe the rejection as against claims 2, 6, and 13. Applicants believe that this is a typographical error in the office action and that the Examiner intended to reject claim 6 and not claim 16 in this group of rejections. Accordingly, Applicants put forth arguments against obviousness rejection of claims 2, 6, and 13 below.

The Examiner has rejected claim 2 stating:

As per claim 2, Neumark discloses the method of claim 1 as discussed above in 35 U.S.C. 102(a) rejection section.

Neumark does not explicitly disclose said device is fixedly mounted to a shopping cart.

However, *Hind* discloses said device fixedly mounted to a shopping cart (Figure 3, paragraph 12). It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because the combination would have provided targeted advertising and personalized service to the customer using the display device on the shopping cart (paragraph 12).

Final office action dated August 22, 2006, p. 7.

Claim 2 is representative of claims 2, 6, and 13 in this group and recites:

The method of claim 1, wherein said device is fixedly mounted to a shopping cart.

A. The Proposed Combination Does Not Teach all of the Features of Claim 2

Regarding the features of claim 2, the Examiner has failed to state a prima facie obviousness rejection because the proposed combination does not teach all of the features of claim 2. A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. In re Lowry, 32 F.3d 1579, 1582,

32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In the case at hand, not all of the features of the claimed invention have been considered and the teachings of the references themselves do not suggest the claimed subject matter to a person of ordinary skill in the art.

Because *Neumark* does not anticipate claim 1 as described in section II.A above, *Neumark* also does not disclose all features of claim 2, which depends from claim 1. *Hind* does not cure these deficiencies in *Neumark* and therefore cannot make obvious the invention of claim 2.

Hind's entire disclosure also fails to teach or suggest use and manipulation of planograms as claimed. *Hind* is concerned with providing targeted advertising and services through a user's mobile device. *Neumark* is concerned with cataloging and managing inventory of items through use of label scanners. The claimed invention is concerned with updating planograms of retail environments through use of RFID readers. *Hind* does not cure *Neumark*'s shortcoming in teaching the invention of claim 1, and therefore, considered together with *Neumark* cannot make obvious the invention of claim 2. Therefore, the Examiner has failed to establish a prima facie case of obviousness against claim 2 under 35 U.S.C. § 103.

B. The Examiner Has Not Stated a Proper Teaching, Suggestion or Motivation to Combine the References

In addition, the Examiner has failed to state a prima facie obviousness rejection against features of claim 2, because the Examiner has not stated a proper teaching, suggestion, or motivation to combine the references. Instead, the Examiner has only stated a proposed advantage to combining the references. However, an advantage proposed by the Examiner is not a teaching, suggestion, or motivation based on the prior art. To constitute a proper teaching, suggestion, or motivation, the Examiner must establish that one of ordinary skill would both recognize the advantage and have a reason to implement the advantage. For example, a first reference may disclose the use of lasers to achieve nuclear fusion. A second reference may disclose that ultra-high power lasers deliver more energy. One of ordinary skill may recognize that an ultra-high power laser would be more useful to achieve nuclear fusion, though one of ordinary skill would be motivated to avoid combining the references because of the extreme expense of ultra-high power lasers. In this example, one of ordinary skill is motivated to avoid

implementing the combination, even if he or she recognized the advantage, and so no teaching, suggestion, or motivation exists to combine the references.

In the case at hand, the Examiner has not provided a sufficient reason why one of ordinary skill would recognize the proposed advantage or have a reason to implement it. Instead, the Examiner points to features in the cited reference that give the Examiner motivation to combine them, rather than pointing to the motivation in the prior art. The Examiner states, “It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because the combination would have provided targeted advertising and personalized service to the customer using the display device on the shopping cart.” However, the proposed motivation does not actually exist because *Neumark’s* method discloses no desirability or need for providing targeted advertising to the customer. *Neumark* is concerned with inventory management, not advertising to the customers, whether targeted or not. *Hind* has no component, which participates in an inventory management function that is of interest to *Neumark*. *Neumark* provides a complete system and method for accomplishing inventory management function and is not deficient in supporting that function. Because *Neumark* is not lacking in this capability, *Neumark’s* existing disclosure vitiates any putative need for *Hind’s* teachings. For these reasons, the Examiner’s statement fails to provide a proper teaching, suggestion, or motivation to combine the references. Accordingly, the Examiner has failed to state a prima facie obviousness rejection against claim 2.

C. No Teaching, Suggestion, or Motivation Exists to Combine the References

In addition, a prima facie obviousness rejection against features of claim 2, has not been made because no proper teaching or suggestion to combine the references exists in the references. A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). A proper prima facie case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). No such teaching or suggestion is present in the cited references and the Examiner has not pointed out any teaching or suggestion that is based on the prior art.

The references themselves do not suggest the proposed advantage. In the present case, *Neumark* has neither a need, nor an advantage in providing targeted advertising to customers while doing the inventory management. *Neumark's* invention discusses racks tens of feet high, items placed on these racks that are tens of feet high, and discusses the need for the label reader to be in close proximity with the items being read. Clearly, *Neumark* is not intending for customers to be climbing forklifts and ladders to read labels on items situated tens of feet high. *Neumark* is therefore a warehouse, or retail operations oriented application and not a customer-oriented application. When there are no customers, no need arises for providing targeted customer advertisements within the scope of the application. Therefore, no need actually exists in *Neumark*, to combine, or provide motivation to combine *Hind* with *Neumark* to deliver targeted advertising to customers. Accordingly, the Examiner has not actually stated a teaching or suggestion based on the references to combine the references. Instead, the Examiner has only put forth a hypothetical advantage of combining the references based on the Examiner's opinion rather than on a pre-existing teaching, suggestion, or motivation found in the references themselves. Thus, the Examiner has failed to state a prima facie obviousness rejection against claim 2.

D. No Teaching or Suggestion Exists To Combine the References Because Each Reference Represents a Complete Solution to the Problem That Each Solves

Both *Neumark* and *Hind* represent complete solutions to the problems each solves. *Neumark* shows an inventory management system using mobile label readers capable of communication. *Neumark* has no need to address the problem of providing targeted advertising to customers for the reasons explained in section III.A.iii above. *Neumark* represents a complete solution for fashioning such a system. On the other hand, *Hind* shows a system for delivering targeted advertising to customers using customer's own mobile phone and PDA, or a shopping cart mounted device. *Hind* represents a complete solution for fashioning such a system. *Hind* has no disclosure touching upon inventory management aspects of *Neumark*. Because each reference provides a complete solution to the problem that each reference represents and neither reference indicates that a targeted advertising system can be used for inventory management or vice versa, one of ordinary skill would have no reason to combine or otherwise modify the

references. Accordingly, the Examiner has failed to state a prima facie obviousness rejection against claim 2.

E. The Examiner Used Impermissible Hindsight When Fashioning the Rejection

In addition, the Examiner has failed to state a prima facie obviousness rejection against claim 2, because the Examiner used impermissible hindsight when fashioning the rejection. Personal opinion cannot be substituted for what the prior art teaches because a prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). In this case, the Examiner believes that, “the combination would have provided targeted advertising and personalized service to the customer using the display device on the shopping cart.” However, as described above, *Neumark* has no need for targeted advertising to customers because *Neumark* is concerned with inventory management. *Hind* fails to provide a reason to include a shopping cart mounted display device in *Neumark* to somehow contribute towards *Neumark*’s system, in the manner claimed by the Examiner. Thus, neither reference teaches or suggests using a display device, as claimed. Given that *Neumark* has no need for displays, and given that *Hind* suggests no reason to use a display in inventory management, one of ordinary skill would have no reason to combine or otherwise modify the references.

Based on the plain disclosures in the references, the only suggestion to modify the references is found in Applicant’s specification. Hence, the Examiner must have used Applicant’s specification to find a teaching, suggestion, or motivation to combine the references. Doing so is impermissible hindsight and fails to comport with the standards of *Graham v. John Deere Co.*, 383 U.S. 1 (1966), which requires a proper teaching, suggestion, or motivation to combine or modify references to achieve a proper obviousness rejection. Accordingly, the Examiner has failed to state a prima facie obviousness rejection against claim 2.

F. *Neumark* and *Hind* Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 2, because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which

fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992); In re Wood, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). The cited references do not address the same problems.

In the case at hand, *Neumark* shows an inventory management system using mobile label readers capable of communication. *Neumark* has no need to address the problem of providing targeted advertising to customers for the reasons explained in section III.A.iii above. *Hind* shows a system for delivering targeted advertising to customers using customer's own mobile phone and PDA, or a shopping cart mounted device. *Hind* represents a complete solution for fashioning such a system. *Hind* has no disclosure touching upon inventory management aspects of *Neumark*. Furthermore, neither reference is in the area of endeavor of the claimed invention – updating a retail planogram.

Thus, the references address distinct problems that are unrelated to each other. The purpose, method, and systems used, as disclosed in *Hind* are inconsistent with those disclosed in *Neumark* as well as those disclosed in the present invention. Because the references address distinct problems, and each of these problems are further distinct from the problem of the claimed invention, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the Examiner. Accordingly, the Examiner has failed to state a prima facie obviousness rejection against claim 2.

Nevertheless, the Examiner responds to these distinctions by stating:

In response to Applicant's argument that there is no suggestion to combine references as to make the combination proper, Examiner respectfully submits that there are three possible sources for a motivation to combine references:

"Reason, suggestion, or motivation to combine two or more prior art references in single invention may come from references themselves, from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in particular field, or from nature of problem to be solved;" Pro-Mold and Tool Co. v. Great Lakes Plastics Inc. U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided February 7, 1996 Nos. 95-1171, -1181.

Final office action dated August 22, 2006, p. 4.

The examiner has not responded to the Applicants/Appellants reasoning that the proposed combination does not teach or suggest all of the features of claim 2. Appellants believe that the examiner has not responded because the examiner is persuaded on this point. Therefore, by this reason alone, the rejection of claim 2 has been overcome.

The examiner is also non-responsive to the remaining reasons in that the examiner only makes statements that are not responses at all. For example, as to the reasoning that each reference represents a complete solution to the problem that each solves, the examiner simply states:

“Question is whether there is something in prior art as whole [sic] to suggest desirability, and thus obviousness, of making combination [sic].”

Final office action dated August 22, 2006, p. 4.

This statement is insufficient to show that some desirability does in fact exist in the references to make the proposed combination. Appellants have shown why no such “desirability” exists in the references. The examiner has failed to show why the desirability exists. Stating an alleged rule is not a sufficient rebuttal unless facts can be shown to fit the rule. The examiner has made no such showing, and therefore the examiner has not overcome the specific additional reason against obviousness of claim 2.

As another example, Appellants reasoned that no teaching, suggestion, or motivation exists to combine the references. The examiner states in response:

In response to Applicant's argument that there is no suggestion to combine references as to make the combination proper, Examiner respectfully submits that there are three possible sources for a motivation to combine references:

"Reason, suggestion, or motivation to combine two or more prior art references in single invention may come from references themselves, from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in particular field, or from nature of problem to be solved;" Pro-Mold and Tool Co. v. Great Lakes Plastics Inc. U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided February 7, 1996 Nos. 95-1171, -1181.

Final office action dated August 22, 2006, p. 4.

Appellants stipulate that the examiner is correct in stating the rule as to the various sources of the motivation. However, stating a rule is not a sufficient rebuttal unless facts can be

shown to fit the rule. The examiner has made no such showing. The examiner has not responded why the Appellants reasoning that the references are not the source of any motivation to combine as proposed. As to the remaining two sources of motivation, whether the source used by the examiner was “the knowledge of those skilled in the art,” or “nature of problem to be solved,” the examiner does not say. The examiner provides neither the basis, nor the support, for finding that Appellants’ reasoning as to motivation is wrong. Therefore, the examiner has not overcome the specific additional reason against obviousness of claim 2.

The examiner’s response as to the use of improper hindsight, the examiner has similarly only stated the rationale as to reconstruction based upon hindsight reasoning. Why the applicants are incorrect in reasoning that the examiner used the disclosure in the present disclosure in hindsight, the examiner does not say. The examiner points to nothing in support that only the knowledge of those skilled in the art at the time of the invention was used. Blanket allegations of the existence of alleged rules, in and of themselves are not sufficient to overcome the fact based reasoning advanced by Appellants. Therefore, the examiner’s response does not overcome the reasons presented against the obviousness of claim 2. Accordingly, Applicants request that the Board of Patent Appeals and Interferences reverse the rejection and direct the examiner to allow the claims in group 3.

III. GROUND OF REJECTION 3 (Claim 17)

Group D: Claim 17

The Examiner has also rejected claim 17 under 35 U.S.C. § 103(a) as being obvious over *Neumark* in view of *Hoffman* et al., Customer Guidance System for Retail Store, United States Patent Application 2002/0178013 (Filed, May 22, 2001, Published, November 28, 2002) (hereinafter, “*Hoffman*”). This rejection is respectfully traversed.

The Examiner has rejected claim 17 stating:

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Neumark* in view of U.S. Publication Number 2002/0178013 issued to Beth Louise Hoffman (hereinafter “*Hoffman*”).

As per claim 17, *Neumark* discloses the system of claim 11 as discussed above in 35 U.S.C. 102(a) rejection section.

Neumark does not explicitly disclose a display for displaying an updated planogram.

However, Hoffman discloses a display for displaying an updated planogram (paragraph 36). It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because Hoffman's planogram display device would have enabled Neumark's system to provide visual display to users to enhance personalized services, such as providing location information of a certain product (paragraph 2 - 3).

Final office action dated August 22, 2006, pp. 11-12.

Claim 17 recites:

The system of claim 11, further comprising a display for displaying an updated planogram.

A. The Proposed Combination Does Not Teach all of the Features of Claim 17

Regarding the features of claim 17, the Examiner has failed to state a prima facie obviousness rejection because the proposed combination does not teach all of the features of claim 17. In the case at hand, not all of the features of the claimed invention have been considered and the teachings of the references themselves do not suggest the claimed subject matter to a person of ordinary skill in the art.

Because *Neumark* does not anticipate claim 10 as described in section II.B above, *Neumark* also does not disclose all features of claim 17, which depends from claim 10. *Hoffman* does not cure these deficiencies in *Neumark* and therefore cannot make obvious the invention of claim 17.

Hoffman is concerned with providing a customer guidance system to assist in locating items on a customer's shopping list via printed or displayed information. *Neumark* is concerned with cataloging and managing inventory of items through use of label scanners. The claimed invention is concerned with updating planograms of retail environments through use of RFID readers. *Hoffman* does not cure *Neumark's* shortcoming in teaching the invention of claim 10, and therefore, considered together with *Neumark* cannot make obvious the invention of claim 17. Furthermore, because *Hind* also does not cure *Neumark's* shortcoming in this regard, *Hoffman* and *Hind* together in combination with *Neumark* fail to teach the invention of claim 10, and therefore, fail to teach the invention of claim 17.

Therefore, the Examiner has failed to make a prima facie case of obviousness against claim 17 under 35 U.S.C. § 103.

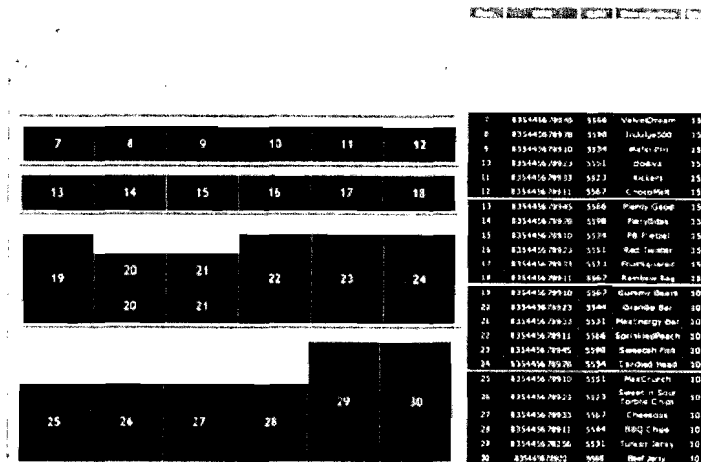
B. The Examiner Has Not Stated a Proper Teaching, Suggestion or Motivation to Combine the References

In addition, the Examiner has failed to state a prima facie obviousness rejection against features of claim 17, because the Examiner has not stated a proper teaching, suggestion, or motivation to combine the references. Instead, the Examiner has only stated a proposed advantage to combining the references. However, an advantage is not necessarily a teaching, suggestion, or motivation. To constitute a proper teaching, suggestion, or motivation, the Examiner must establish that one of ordinary skill would both recognize the advantage and have a reason to implement the advantage.

In the case at hand, the Examiner has not provided a sufficient reason why one of ordinary skill would recognize the proposed advantage or have a reason to implement it. The Examiner states, “It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because *Hoffman*’s planogram display device would have enabled *Neumark*’s system to provide visual display to users to enhance personalized services, such as providing location information of a certain product.”

First, the Examiner’s characterization of *Hoffman*’s display as a “planogram display” is erroneous because *Hoffman*’s product location information is simply a map and not a planogram. *Hoffman*’s disclosure provides no support for the Examiner’s mischaracterization of *Hoffman*’s location map as a planogram. A map in *Hoffman*’s case may be nothing more than a line drawing connecting points, or an ordered listing of product, aisle, and rack information. A planogram displays dimensioned view of the retail space layout and is far more informative than a map that meets *Hoffman*’s description and requirements. A sample planogram is shown below to provide a better understanding of the described difference.

Check Out Lane Planogram



Source: http://www.smartdraw.com/examples/fpn-planograms/planogram_schematic.htm

Next, the proposed motivation does not actually exist because *Neumark's* method discloses no desirability or need for providing “visual display to users to enhance personalized services, such as providing location information of a certain product.” *Neumark* is concerned with inventory management, not personalized services to the customers, whether enhanced or not. *Hoffman* has no component, which participates in an inventory management function that is of interest to *Neumark*. *Neumark* provides a complete system and method for accomplishing inventory management function and is not deficient in supporting that function. Because *Neumark* is not lacking in this capability, *Neumark's* existing disclosure vitiates any putative need for *Hoffman's* teachings. For these reasons, the Examiner’s statement fails to provide a proper teaching, suggestion, or motivation to combine the references. Accordingly, the Examiner has failed to state a prima facie obviousness rejection against claim 17.

C. No Teaching, Suggestion, or Motivation Exists to Combine the References

In addition, the arguments advanced in section III.A.iii above, apply similarly to the rejection of claim 17 as well. A prima facie obviousness rejection against features of claim 17 has not been made because no proper teaching or suggestion to combine the references exists in the references. No teaching or suggestion is present in the cited references and the Examiner has not pointed out any teaching or suggestion that is based on the prior art.

D. No Teaching or Suggestion Exists To Combine the References Because Each Reference Represents a Complete Solution to the Problem That Each Solves

Both *Neumark* and *Hoffman* represent complete solutions to the problems each solves. The arguments advanced in section III.A.iv above, apply similarly to the rejection of claim 17 as well. Because each reference provides a complete solution to the problem that each reference represents and neither reference indicates that a customer guidance system can be used for inventory management or vice versa, one of ordinary skill would have no reason to combine or otherwise modify the references. Accordingly, the Examiner has failed to state a prima facie obviousness rejection against claim 17.

E. The Examiner Used Impermissible Hindsight When Fashioning the Rejection

In addition, the Examiner has failed to state a prima facie obviousness rejection against claim 17, because the Examiner used impermissible hindsight when fashioning the rejection. Personal opinion cannot be substituted for what the prior art teaches because a prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. In *re Bell*, 991 F.2d at 783. In this case, the Examiner believes that, “It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because *Hoffman*’s planogram display device would have enabled *Neumark*’s system to provide visual display to users to enhance personalized services, such as providing location information of a certain product.” However, as described above, *Neumark* has no need to provide visual display to users to enhance personalized services because *Neumark* is concerned with inventory management. *Hoffman* fails to provide a reason to include a display device for displaying an updated planogram in *Neumark* to somehow contribute towards *Neumark*’s system, in the manner claimed by the Examiner. Thus, neither reference teaches or suggests using a display device, as claimed. Given that *Neumark* has no need for displays, and given that *Hoffman* suggests no reason to use a display in inventory management, one of ordinary skill would have no reason to combine or otherwise modify the references.

Based on the plain disclosures in the references, the only suggestion to modify the references is found in Applicant’s specification. Hence, the Examiner must have used Applicant’s specification to find a teaching, suggestion, or motivation to combine the references.

Doing so is impermissible hindsight and fails to comport with the standards of *Graham*, 383 U.S. 1, which requires a proper teaching, suggestion, or motivation to combine or modify references to achieve a proper obviousness rejection. Accordingly, the Examiner has failed to state a prima facie obviousness rejection against claim 17.

F. *Neumark and Hoffman* Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 17, because the references are directed towards solving different problems. The arguments advanced in section III.A.vi above, apply similarly to the rejection of claim 17 as well. The purpose, method, and systems of *Hoffman* are inconsistent with those of *Neumark*, and further inconsistent with those of the present invention. Because the references address distinct problems, and each of these problems are further distinct from the problem of the claimed invention, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the Examiner. Accordingly, the Examiner has failed to state a prima facie obviousness rejection against claim 17.

The examiner has rejected all of the above reasoning by stating:

Traversed based on the same rationale above.

Final office action dated August 22, 2006, p. 5.

Consequently, the examiner's response as to the reasoning against obviousness of the claim in this group is flawed in the manner described in section II.G above. The examiner points to nothing to support that the alleged rules are in fact supported by facts of the references. Blanket allegations of the existence of alleged rules, in and of themselves are not sufficient to overcome the fact based reasoning advanced by Appellants. Therefore, the examiner's response does not overcome the reasons presented against the obviousness of claim 17. Accordingly, Applicants request that the Board of Patent Appeals and Interferences reverse the rejection and direct the examiner to allow the claims in group 4.

IV. CONCLUSION

For the foregoing reasons, *Neumark* does not anticipate claims in groups 1 and 2; *Neumark* in view of *Hind* does not make obvious the claims in group 3; and *Neumark* in view of *Hoffman* does not make obvious the claim in group 4. The examiner has failed to make a prima facie case of anticipation or obviousness in each of these rejections. Therefore, Applicants respectfully urge that the Board of Appeals reverse the rejection of claims 1-20 under 35 U.S.C. §§ 102(a) and 103(a) and direct the examiner to allow the claims.

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CLAIMS APPENDIX

The text of the claims involved in the appeal are:

1. A method for updating a retail planogram comprising the steps of
reading an electronic transmission from at least one RFID tag in a retail environment located in
proximity to a product, using a personal shopper device having a location sensing mechanism, a
memory, a software means, and an RFID reader, wherein an initial planogram is stored therein,
collecting said read electronic location information transmitted from said at least one
RFID tag by said shopper device,
analyzing and comparing said collected location information by said software means of
said shopper device, with said initial planogram in relation to initial location information of said
product with collected location information for said product from said collected information,
updating said initial location information for said product in said initial planogram in
response to collected location information to provide an updated planogram to display current
location information for said product in a current planogram arrangement in said retail
environment.
2. The method of claim 1, wherein said device is fixedly mounted to a shopping cart.
3. The method of claim 1, wherein said RFID tag is an RFID shelf tag.

4. The method of claim 3 wherein said method further comprises the step of transmitting said analyzed information to a retail server wherein a database map of product locations is generated in relation to their respective RFID shelf tags.
5. The method of claim 4, wherein said read electronic information includes unique product identifiers and unique location identifiers indicating unique information about products in said retail environment.
6. The method of claim 3, wherein said method is performed by a consumer.
7. The method of claim 3, wherein said method is performed by a retailer.
8. The method of claim 3, wherein all product labels in said retail environment are RFID shelf tags.
9. The method of claim 3, further comprising the step of generating an updated planogram.
10. A system for updating a planogram comprising,
a personal shopper device having a location sensing means, a software means and an RFID reader,
a retail system comprising a database in communication with said shopper device,
an initial planogram stored in said database, and
one or more product RFID shelf labels positioned in a retail environment,

wherein said RFID reader is capable of reading an electronic transmission from at least said one or more RFID shelf labels using said personal shopper device and transmitting collected read electronic information to said database, wherein said initial planogram is updated in response to collected read electronic information by said software means and said database is updated with a current planogram reflecting said collected read electronic information.

11. The system of claim 10, wherein said software means is software that compares initial product location information with collected product location information and identifies differences therebetween.

12. The system of claim 11, wherein said location sensing means reads coordinates from known location points within said retail environment to determine a coordinate location point of said shopper device at an instant of time.

13. The system of claim 11, wherein said shopper device is a hand-held device having a display in wireless communication with said retail system.

14. The system of claim 11, wherein said RFID shelf label further comprise visible product information including per unit price.

15. The system of claim 11, wherein said RFID label transmits electronic information including unique product identifiers and unique location identifiers indicating unique information to said RFID reader.

16. The system of claim 11, wherein all product labels in said retail environment are RFID shelf tags.

17. The system of claim 11, further comprising a display for displaying an updated planogram.

18. The system of claim 11, further comprising a printer for printing an updated planogram.

19. A system for generating an updated planogram in a retail environment comprising, a portable shopper device having a location sensor, comparative software and an RFID reader, a retail system comprising a server, a database in communication with said shopper device, a wireless communication network,

an initial planogram stored in said database, and

a plurality of product RFID shelf labels positioned in proximity to each of their respective products,

wherein said RFID reader reads product location information electronically transmitted from at least one of said plurality of product RFID shelf labels using said personal shopper device and said comparative software compares initial product location information of said initial planogram with said read product location information and updates said initial planogram in response to said read product location information and said database is updated with a current planogram in relation to said read product location information.

20. The system of claim 19, wherein said database stores said initial planogram and said current planogram concurrently.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.